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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,608	11/14/2001	Barbara Sheila Goldberg	1223.0050000	7303

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EXAMINER

PRUNNER, KATHLEEN J

ART UNIT	PAPER NUMBER
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3751

DATE MAILED: 02/24/2004

*19*

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/936,608

Applicant(s)

GOLDBERG ET AL.

Examiner

Kathleen J. Prunner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3-7 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-7 and 11-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date 14.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. New corrected drawings are required in this application because the new formal drawings filed August 18, 2003 (Paper No. 18) were disapproved by the Draftsman (note the attached form, PTO-948). Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Specification***

2. The following informalities in claims 1, 3-7 and 11-14 are noted: (A) in claim 1, on line 5, "enveloped" is misspelled. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1 and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamaguchi et al. (EP 734,722). Yamaguchi et al. disclose an adhesive dispensing arrangement having all the claimed features including a patch (constituted by layer 5) for covering the area to be treated, the patch being provided with an adhesive surface (note line 17 in col. 7) for allowing the patch to stick or adhere to the surface (note lines 31-32 in col. 7), a peelable backing (constituted by layer 2) covering the adhesive surface (note Fig. 1), an applicator constituted by layer 8 (note Fig. 9), a

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dispensing container (constituted by storage layer 4) substantially fully enveloped by the patch 5 and the peelable backing 2 (note Fig. 9), the dispensing container 4 accommodating a substance to be dispensed (note lines 13-24 in col. 4), the substance to be dispensed being housed apart from the applicator 8 and being situated fully between the backing 2 and the patch 5 (note Fig. 9), a release agent (constituted by releasable liner layer 6, note lines 26-28 in col. 14) cooperating with the peelable backing 2 and the dispensing container 4 in such a manner that when the backing 2 is peeled from the adhesive surface the release agent 6 enables the dispensing container 4 to open or rupture to release the substance from the opened or ruptured dispensing container 4 onto the applicator 8 (note lines 40-44 in col. 9), and the applicator 8 being arranged to apply an effective amount of the substance to the area to be treated when the patch 5 is stuck to the area (note lines 54-56 in col. 7), the dispensing container 4 being a premanufactured container (note lines 21-24 in col. 4). With respect to claim 11, Yamaguchi et al. also disclose that the patch 5 and the peelable backing 2 define an outer sealed container within which the dispensing container 4 is housed (note Fig. 9). With respect to claim 12, Yamaguchi et al. further disclose that the adhesive dispensing arrangement is in the form of a bandage (note lines 16-21 in col. 9) for medical application with the substance being a medicament (note lines 25-59 in col. 4). With regard to claim 13, Yamaguchi et al. additionally disclose that substance is used to treat selected areas (note lines 6-9 in col. 9) and is a drug constituting a chemical treatment (note lines 1-41 in col. 5).

*Claim Rejections - 35 USC § 103*

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 3-7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al. in view of Sabatano. With respect to claim 3, although Yamaguchi et al. fail to disclose that the applicator includes an absorbent pad, attention is directed to Sabatano who discloses another patch/bandage that uses an applicator which includes at least one absorbent pad 13 secured to the patch 11 along at least one marginal adhering zone with a non-adhering zone (constituted by the top surface thereof as shown in Fig. 2) being interposed between the dispensing container 14 and the backing 22 (note Fig. 2) for receiving the substance 15 to be dispensed from the container 14 after outlet opening 16 is exposed (note lines 20-29 in col. 2). It would have been obvious to one of ordinary skill in the patch/bandage art, at the time the invention was made, to form the applicator of Yamaguchi et al. with an absorbent pad in view of the teachings of Sabatano in order to allow the medication/drug to have a longer residence time in contact with the area to be treated as well as a more cushioning effect over that area for protection. With regard to claim 4, Yamaguchi et al. further disclose that the release agent 6 is adhesively secured to the peelable backing 2 whereby the release agent 6 is arranged to be simultaneously peeled away with the backing 2 to rupture or open the dispensing container 4 (note lines 25-31 in col. 7). With regard to claim 5, Yamaguchi et al. additionally disclose that the release agent comprises at least one aperture (note Fig. 2) defined in the dispensing container 4 and a removable sealing strip 6 for sealing off the aperture with the sealing strip 6 being arranged to expose the aperture on removal thereof. With respect to claim 6, Sabatano further

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teaches the obviousness of extending the sealing strip between the dispensing container and the non-adhered zones of the pad whereby the pad is arranged temporarily to splay outwardly to allow the sealing strip to exit as it is peeled away from the dispensing container (note Fig. 2). With regard to claim 7, Yamaguchi et al. further disclose that the patch can contain two or more absorbable drugs if such is necessary for proper treatment (note lines 1-2 in col. 5) of the patient. With regard to claim 14, Yamaguchi et al. additionally disclose that release agent comprises a rupturing aid (constituted by notches 7) for removing or opening a rupturable zone on the dispensing container 4 so as to provide an opening in the dispensing container 4 (note Fig. 1).

### ***Response to Arguments***

7. Applicant's arguments filed August 18, 2003 (Paper No. 17) have been fully considered but they are not deemed persuasive.

8. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a dispensing arrangement is a discrete unit in which a substance is bounded on all sides) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).


9. Applicant's arguments regarding the Yamaguchi et al. reference have been carefully considered. However, Yamaguchi et al. does indeed disclose that the dispensing container 4 is substantially fully enveloped by the patch and the peelable backing, as pointed out in the above rejection of the claims.

*Conclusion*

10. Any inquiry concerning this communication from the examiner should be directed to Examiner Kathleen J. Prunner whose telephone number is 703-306-9044. The examiner can usually be reached Monday through Friday from 5:30 AM to 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory L. Huson can be reached on 703-308-2580. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Kathleen J. Prunner

February 20, 2004



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